

REMARKS

Reconsideration and withdrawal of the election of species requirement are respectfully requested in view of the above amendments and following remarks. Claims 1-16 and 18-34 are pending herein.

Applicants hereby provisionally elect, with traverse, to prosecute the species that includes claims 1-8. Claims 33 and 34 are generic to the species. It is respectfully submitted that at least claims 1-8 of the elected species and generic claims 33 and 34 should be examined together. Claims 33 and 34 are combination claims featuring a component audit and inventory management system that is generic to and links all of the subcombination species featured in claims 1-16 and 18-22. The features of the subcombination claims are used in the combination of claims 33 or 34.

Patent Office practice where there is a generic claim is described in MPEP 806.05(d) and 806.04(d):

Where subcombinations as disclosed and claimed are both
(a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be permitted.

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim.

The subcombination claims are clearly related to each other. The subcombinations are used in the combination featured in claims 33 or 34. Therefore, upon the allowance of generic claims 33 or 34 it is submitted that all of claims 1-16 and 18-22, including any non-elected species claims, should also be allowable.

In addition, claims 23-32 feature methods for component audit and inventory management that include functions, operations or interactions of the structural elements

of the component audit and inventory management system of claim 34. It is submitted that claim 34 is a linking claim, under MPEP 809.03, which links the method and apparatus claims by virtue of its means-plus-function terminology.

Patent Office practice regarding linking claims is set forth in MPEP 809:

The linking claim must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.

Therefore, it is respectfully submitted that linking claim 34 should be examined now and that upon its allowance, method claims 23-32 should also be examined in this application.

Moreover, notwithstanding the foregoing, the avowed purpose of the Patent and Trademark Office in requiring restriction is the avoidance of a burdensome examination and multiple searches. However, MPEP §803 provides that if the search and examination of an entire application can be made without serious burden the Examiner must do so even if it is considered to include claims to two different or independent inventions.

It is respectfully submitted that the examination of all of the claims of this application will not place an undue burden on the PTO. Accordingly, Applicants respectfully request that the Examiner withdraw the election of species requirement and that he concurrently examine the claims of all species together in this application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820 and Order No. GWL.36054.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Paul A. Serbinowski, Reg. No. 34,429

PEARNE & GORDON LLP

Ohio Savings Building

12th Floor

1801 East 9th Street

Cleveland, OH 44114

Telephone: (216) 579-1700

Facsimile: (216) 579-6073

E-mail: ip@pearnegordon.com

Date: November 18, 2004